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10/562,387	05/11/2006	Christiaan Michiel Ten Bruggenkate	ALG10220P-50	8142

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
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CHICAGO, IL 60661

EXAMINER

EIDE, HEIDI MARIE

ART UNIT	PAPER NUMBER
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3732

MAIL DATE	DELIVERY MODE
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11/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/562,387

Applicant(s)TEN BRUGGENKATE,
CHRISTIAAN MICHIEL**Examiner**

Heidi M. Eide

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 16 and 40'. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 10, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). As to claim 14, it is unclear if the applicant is actually claiming the limitation contained in the brackets.

5. Claim 1 recites the limitation "said bone tissue" in lines 2 and 10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Niznick et al. 5,427,527 (Niznick).

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8. Niznick discloses an intra-osseous implant for placement in a bone of a human comprising at least one intra-osseous part intended for placement in the bone tissue having an apical side and a cervical side and inherently composed of a body friendly material, which part is provided on its circumferential surface with a screw thread running in the direction of and ending at the apical end and a support part present at the cervical side of the at least one intra-osseous part intended for supporting a prosthetic element (see abstract) characterized in that the intra-osseous part is provided with multiple grooves 33 extending in longitudinal direction and over the entire length of the intra-osseous part interrupting the screw thread into multiple interrupted screw thread parts as illustrated in fig. 3A-3B. Niznick does not specifically teach the multiple interrupted screw thread parts serving as retention elements allowing the placement of the implant in the longitudinal direction into the bone tissue but prevention the removal of the implant in opposite longitudinal direction out the bone, however, Niznick teaches the apparatus as claimed, therefore, it is capable of functioning as claimed. Niznick further teaches the depth of the groove is greater than the height of the screw thread (col. 4, ll. 7-13). Niznick further teaches the grooves are in an equidistant manner in the circumferential surface as illustrated in fig. 3A and that the intra-osseous part has a cylindrical cross section (col. 4, ll.1-2).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick) as applied to claim 1 above, and further in view of Alvaro 6,099,312.

11. Niznick teaches the invention as discussed above, however, does not teach the width of the groove varies in the direction of the apical side of the intra-osseous part more particularly it widens. Alvaro teaches the width of the groove varies in the direction of the apical side as illustrated in fig. 4, however does not specifically teach it widens in the direction of the apical side, however, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Niznick in view of Alvaro since it has been held that the configuration of the claimed implant was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed implant was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick) as applied to claim 1 above, and further in view of Vogt et al. 2004/0096804 (Vogt).

13. Niznick teaches the invention as discussed above, however does not teach the depth of the grooves varies in the direction of the apical side of the intra-osseous part and more particular becomes larger. Vogt teaches the groove becomes larger in the direction of the apical side as illustrated in fig. 5B. It would have been obvious to one

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having ordinary skill in the art at the time of the invention to modify Niznick in view of Vogt since it has been held that such a modification would have involved a mere change in the size of a component which is recognized as being within the level of ordinary skill in the art (*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) MPEP 2144.04 IV A).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick) as applied to claim 1 above, and further in view of Misch et al. 5,954,504 (Misch). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Niznick in view of Misch since it has been held that such a modification would have involved a mere change in the size of a component which is recognized as being within the level of ordinary skill in the art (*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) MPEP 2144.04 IV A).

15. Niznick teaches the invention as discussed above, however, does not teach the height of the screw thread varies in the direction of the apical side of the intra-osseous part and more in particular becomes smaller. Misch teaches the height of the screw thread varies in the direction of the apical side of the intra-osseous part and more in particular becomes smaller as illustrated in fig. 5.

16. Claims 10-11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick) as applied to claim 1 above, and further in view of Kanomi et al. (Kanomi).

17. Niznick teaches the invention as discussed above, however does not teach the intra-osseous part has a near cylindrical cross section, for example, conical, elipsonal,

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oval cross section or a polygonal cross section more specifically a hexagonal or octagonal cross section. Kanomi teaches an oval and polygonal cross section (col. 7, ll. 47-49). Kanomi does not specifically teach a hexagonal or octagonal cross section, however, it would have been an obvious matter of design choice to one having ordinary skill in the art since Kanomi teaches a polygonal cross section which hexagonal and octagonal are. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Niznick in view of Kanomi since it has been held that the configuration of the claimed implant was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed implant was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

18. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick).

19. Niznick teaches the invention as discussed above, however, does not teach the intra-osseous part becomes smaller in the apical direction in combination with all the limitations of claim 1. Niznick, however, does teach the intra-osseous part becomes smaller in the apical direction as illustrated in fig. 2. It would have been obvious to one having ordinary skill in the art to modify Niznick to include the intra-osseous part becomes smaller in the apical direction since it has been held that the configuration of the claimed implant was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration

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of the claimed implant was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

20. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick) as applied to claim 1 above, and further in view of Lonca 4,722,688.

21. Niznick teaches the invention as discussed above, however, does not teach the support part is positioned under an angle on the intra-osseous part with respect to the direction of the implant. Lonca teaches the support part is positioned under an angle on the intra-osseous part with respect to the direction of the implant as illustrated in figs. 4a-4b (col. 4, ll. 20-23). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Niznick in view of Lonca in order to provide a prosthetic in desired position preferred by the user.

22. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niznick et al. 5,427,527 (Niznick) as applied to claim 1 above, and further in view of Daftary 5,759,034.

23. Niznick teaches the invention as discussed above, however, does not teach the support part is provided with at least one bevel on its circumferential edge. Daftary teaches the support part is provided with at least one bevel on its circumferential edge as illustrated in fig. 2. It would have been obvious to one having ordinary skill in the art to modify Niznick in view of Daftary since it has been held that the configuration of the claimed implant was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the

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claimed implant was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi M. Eide whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heidi Eide
Examiner
Art Unit 3732

/John J Wilson/
Primary Examiner
Art Unit 3732

/Heidi M Eide/
Examiner, Art Unit 3732

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